

Appl. No. 10/633,853
Response to Final Action of December 22, 2005

Amendments to the Drawings:

The attached sheets of drawings include changes to FIGURES 3A and 5A. New drawing sheets 1/4 and 3/4, which include FIGURES 3A and 5A, respectively, replace the original sheets. Section line label "3B" has been changed to "3" on sheet 1/4 and section line label "5B" has been changed to "5" on sheet 3/4.

Attachment: Replacement Sheets
Annotated Sheets Showing Changes

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Remarks:

1. Claims 1 through 39 were originally presented in this application. No claims have been added or canceled during prosecution of this case. Claims 1-39 remain pending.

2. Applicants wish to thank the Examiner for providing a telephone interview on March 20, 2006. Applicants have enclosed an interview summary herewith in accordance with MPEP 713.04.

3. In Paragraph 1 of the Final Action, the Examiner objected to the drawings because FIGURES 3A and 5A include section lines that are labeled alphanumerically instead of with Arabic or Roman numerals (37 CFR 1.84(h)(3)). Applicants submit corrected drawing sheets herewith in compliance with 37 CFR 1.121(d). Applicants refer the Examiner to new drawing sheets 1/4 and 3/4 in which FIGURES 3A and 5A, respectively, have been amended to change the section line labels. In particular, section line label "3B" has been changed to "3" on FIGURE 3A and section line label "5B" has been changed to "5" on FIGURE 5A. Paragraphs [0016], [0020], and [0032] of the specification have also been amended to reflect this change. No new matter has been added.

4. In Paragraphs 2 and 3 of the Final Action, the Examiner objected to the abstract of the disclosure for three reasons: (i) because it contains purported merits, (ii) because it contains more than 150 words, and (iii) because it did not commence on a separate sheet. Applicants have amended the abstract of the disclosure to address these concerns. Purported merits have been removed from the abstract. The amended abstract is 121 words. The amended abstract commences on a separate sheet (page 2 of this response).

5. In Paragraphs 8 and 9 (pages 5 through 8) of a first office action (mailed July 12, 2005), the Examiner rejected claims 1-13, 18-31, 34-37 and 39 under 35. U.S.C. 103(a) as being unpatentable over *Ringgenberg et al.* (US Patent 5,799,733) in view of *Michaels et al.* (US Patent 5,303,775). In a response dated November 10, 2005, Applicants amended independent claims 1, 22, 35, and 36 to recite: a "separator separating a sample chamber from a pressure

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balancing chamber in the sample tank, the sample chamber being in fluid communication with formation fluid concurrently with the pressure balancing chamber being in fluid communication with drilling fluid exterior to the pressure balancing chamber.” Applicants further argued that such concurrent fluid communication is not taught by the combination of *Ringgenberg* and *Michaels*.

6. In Paragraphs 5 and 6 of the Final Action, the Examiner again rejected claims 1-13, 18-31, 34-37, and 39 under 35 USC 103(a) as being unpatentable over *Ringgenberg* in view of *Michaels*. In response to the Applicants’ arguments dated November 10, 2005, the Examiner stated that the concurrent fluid communication feature was taught by *Michaels* and that “*Michaels* was combined with *Ringgenberg* to provide the teaching of the sample chamber and pressure balancing chamber and thus teaches the fluid communication of each.”

7. Applicants again traverse this rejection. Applicants respectfully submit that the Examiner has failed to make a *prima facie* case of obviousness according to MPEP 2143. In particular, Applicants submit that there would be no reasonable expectation of success to combine *Ringgenberg* with *Michaels* as suggested by the Examiner to achieve “the sample chamber being in fluid communication with formation fluid concurrently with the pressure balancing chamber being in fluid communication with drilling fluid” recited in independent claims 1, 22, 35, and 36. As described in more detail in Paragraph 8, such modification would require substantial reconstruction and redesign of *Ringgenberg*.

8. As discussed in the telephone interview of March 20, 2006, the structure and function of *Ringgenberg* preclude the concurrent fluid communication feature recited in previously amended claims 1, 22, 35, and 36. In particular, *Ringgenberg* teaches an apparatus having a single longitudinal passage 270 for transporting both drilling fluid and formation fluid. Samplers 234, 235 are deployed in an enlarged bore 230 of longitudinal passage 270. *Ringgenberg* further teaches (e.g., in column 21) a tool having two distinct configurations; (i) a drilling configuration shown on Fig. 3A and (ii) a formation evaluation configuration shown on Fig. 3B. In the drilling configuration (Fig. 3A), circulating valves 236 and 266 are configured

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such that drilling fluid may be pumped from the surface through passage 270 to drill bit 212. In the drilling configuration, the samplers 234, 235 are fully immersed in drilling fluid such that concurrent fluid communication with formation fluid is impossible. In the formation evaluation configuration (Fig. 3B), circulating valves 236 and 266 are configured such that formation fluid may be pumped from port 238 up through passage 270 to sample tank to 282. In the formation evaluation configuration, samplers 234, 235 are fully immersed in formation fluid such that concurrent fluid communication with drilling fluid is impossible. As such, even if *Ringgenberg* could be properly modified to include the sample tanks of *Michaels*, the combination does not teach a "sample chamber being in fluid communication with formation fluid concurrently with the pressure balancing chamber being in fluid communication with drilling fluid" as recited in pending claims 1, 22, 35, and 36. In order to achieve such concurrent fluid communication, substantial reconstruction and redesign of the *Ringgenberg* tool would be required. Accordingly, Applicants respectfully request the Examiner to withdraw her rejection of pending claims 1, 22, 35, and 36.

9. In Paragraph 7 of the Final Action, claims 14-17, 32, 33, and 38 were rejected under 35. U.S.C. 103(a) as being unpatentable over *Ringgenberg* in view of *Michaels* in further view of *Brown et al* (U.S. Patent 5,901,788). Applicants respectfully submit that this rejection is now moot in view of the remarks in Paragraphs 7 and 8 of this paper.

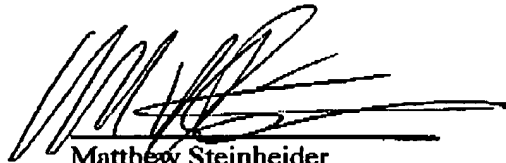
10. Applicants therefore respectfully submit that independent claims 1, 22, 35, and 36 are patentable over the art of record. Independent claims 1, 22, and 36 being allowable, it follows *a fortiori* that dependent claims 2 through 21, 23 through 34, and 37 through 39 must also be allowable, since these dependent claims carry with them all the elements of the independent claims to which they ultimately refer.

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Applicants believe that in view of the foregoing remarks, pending claims 1 through 39 are allowable, and that this application is now in full condition for allowance, which action Applicants earnestly solicit. Should the Examiner have any questions, or believe that a telephone interview may expedite the further examination of this application, the Examiner is requested to contact the undersigned at the telephone number shown below.

Respectfully submitted,

Date: 3/21/06

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